

Remarks

I. Status of the Claims

Claims 55-79 are pending in the application, with claims 55 and 71 being the independent claims.

II. Summary of the Office Action

In the Office Action, the Examiner has made two rejections of the claims. Applicants respectfully offer the following remarks to overcome or traverse each of the rejections.

III. The Rejection Under 35 U.S.C. § 112, First Paragraph

In the Office Action at page 2, section 1, the Examiner has rejected claims 55-79 under 35 U.S.C. § 112, first paragraph, for alleged lack of written description. Specifically, the Examiner contends that:

[c]laim 55, for example, discloses a composition for synthesizing a nucleic acid molecule comprising compounds of formula I. Formula I is a molecule where a nitrogen atom is linked to 4 moieties R1, R2, R3, and A. It is described that R1-R3 can be =O. However a compound comprising a nitrogen linked to four =O is unlikely to be stable or to even exist because the maximum valence for a nitrogen atom is 4.

Paper No. 20 at page 2, section 1, lines 9-14. Applicants respectfully disagree with these contentions.

First, Applicants note that the Examiner is incorrect in stating that, in Formula I, a nitrogen could be linked to four =O moieties. As the Examiner has stated, the nitrogen in Formula I is linked to four moieties: R1, R2, R3 and A. However, according to the definition of

Formula I in the specification and in claim 55, R1, R2 and R3 cannot *all* be =O since the last line of claim 55 clearly states the proviso that "if two of R1, R2 and R3 are =O, then the other is not =O." Similarly, the A group clearly also *cannot* be =O, and is instead at least one carbon atom linked to one or more other groups (see claim 55, first wherein clause). Hence, the Examiner is incorrect in stating that the nitrogen in Formula I could be linked to four =O, since this possibility is clearly excluded by the plain language of claim 55.

Accordingly, Applicants respectfully assert that the present claims are fully enabled by the specification. Reconsideration and withdrawal of the rejection of claims 55-79 under 35 U.S.C. § 112, first paragraph, are respectfully requested.

IV. The Rejection Under 35 U.S.C. § 102(b)

In the Office Action at pages 2-3, sections 2-3, the Examiner has rejected claims 55-62 and 65-79 under 35 U.S.C. § 102(b) as being anticipated by Chamberlin *et al.*, WO 95/20682 (Doc. No. AL1, of record, and cited as Doc. No. "N" on the Form PTO-892 attached to Paper No. 20; hereinafter "Chamberlin"). Applicants respectfully traverse this rejection.

Under 35 U.S.C. § 102, a claim can only be anticipated if every element in the claim is expressly or inherently disclosed in a single prior art reference. *See Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984). In addition, a claim can only be anticipated by a publication if the publication describes the claimed invention with sufficient enabling detail to place the public in possession of the invention. *See In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985); *see also PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996) ("To anticipate a claim, a reference must

disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.”). In the present case, these burdens have not been satisfied.

Applicants first note that the formulae disclosed in Chamberlin at pages 8-12 (the pages referred to by the Examiner in making this rejection) are not identical to those of the present claims. For example, R1, R2 and R3 in Chamberlin are neither =O nor any of the groups specified for R1, R2 and R3 in present claim 55, Formula I. Second, the pyrrolidine ring structure specified in Chamberlin (*see* page 9) does not have the same possible structures as those of Formula II in present claim 55. Hence, for at least these two reasons, Chamberlin fails to disclose all of the elements of the presently claimed invention, and therefore would not enable one of ordinary skill to make and use the claimed invention. Thus, under *Kalman, Donohue* and *PPG Industries*, Chamberlin cannot and does not anticipate the present invention.

In view of the foregoing remarks, Applicants respectfully assert that claims 55-62 and 65-79 are not anticipated by Chamberlin. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are therefore respectfully requested.

V. *Conclusion*

All of the stated grounds of rejection have been properly traversed. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this amendment and remarks, and allowance of all pending claims, are earnestly solicited.

Respectfully submitted,

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Date: July 29, 2002

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